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EXAMINER

VAUGHN, GREGORY J

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RICHARD LEINFELLNER, KARL FITZHUGH,  
and JEFFREY GAMON

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Appeal 2007-3590  
Application 09/495,622  
Technology Center 2100

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Decided: February 25, 2008

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Before JAY P. LUCAS, ST. JOHN COURTENAY III, and STEPHEN C.  
SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's  
Final Rejection of claims 1-7 and 9-21. We have jurisdiction under  
35 U.S.C. § 6(b). We affirm.

#### A. INVENTION

1 The invention at issue involves invoking an electronic messaging system within an application (Spec. 2). In particular, a composite message is formed by combining user-selected multimedia from an application and message information from a message form. The composite message is sent to an intended recipient (*id.* 3).

#### B. ILLUSTRATIVE CLAIMS

Claim 1, which further illustrates the invention, follows:

1. A method of sending an electronic message from within a game application to an intended recipient over a network, comprising:

receiving a user input selecting an image generated by the game application;

generating a message form from within the game application for receiving message information;

combining the selected image and the message information into a composite message; and

sending the composite message from within the game application to the intended recipient over the network.

#### C. REJECTION

Claims 1-4, 7, 9-13, 19, and 21 stand rejected under 35 U.S.C. § 102(a) as being anticipated by SnagIt software, version 4.3 (“SnagIt”). Claims 5, 6, 16, 17, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over SnagIt and U.S. Patent No. 6,400,378 (“Snook”). Claims

14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over SnagIt and U.S. Patent No. 6,424,996 (“Killcommons”). Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. SnagIt and U.S. Patent No. 6,094,277 (“Toyoda”).

## II. CLAIM GROUPING

1 “When multiple claims subject to the same ground of rejection are argued as a group by Appellants, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of Appellants to separately argue claims which Appellants have grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.” 37 C.F.R. § 41.37(c)(1)(vii) (2006).<sup>1</sup>

Appellants argue claims 1-4, 7, 9-13, 19, and 21 as a first group (App. Br. 10-12), claims 5, 6, 16, 17, and 20 as a second group (*id.* 12); claims 14 and 15 as a third group (*id.* 12-13); and claim 18 separately. We select claim 1 as the sole claim on which to decide the appeal of the first group, claim 5 as the sole claim on which to decide the appeal of the second group, and claim 14 as the sole claim on which to decide the appeal of the third group. We consider claim 18 separately.

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<sup>1</sup> We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The current version includes the same rules.

### III. CLAIMS 1-4, 7, 9-13, 19, AND 21

As set forth above, we select claim 1 as the sole claim on which to decide the appeal of claims 1-4, 7, 9-13, 19, and 21. “Rather than reiterate the positions of parties *in toto*, we focus on the issue therebetween.” *Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at \*2 (BPAI 2007).

Appellants argue that SnagIt fails to disclose ““sending the composite message from within the game application to the intended recipient over the network as recited in independent claim 1” because “SnagIt requires an external mail client” (App. Br. 10), whereas claim 1 “does not require a separately installed mail client” (Reply Br. 11).

We agree with the Examiner that SnagIt reads on the disputed feature recited in claim 1 because SnagIt sends a composite message including an image file and an optional short message that is generated from within the application. The composite message that is sent from the application is sent to an intended recipient over a network via a mail client (Fig. 3). “[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). Based on a broad but reasonable interpretation, we find that activating and sending a message from an application (e.g., MS Word – SnagIt, Fig. 4) is equivalent to sending a composite message from within an application as recited in claim 1.

As indicated above, Appellants assert that “SnagIt requires the use of an external mail client for sending messages” (App. Br. 10) and that claim 1

“does not require a separately installed mail client” (Reply Br. 11).

However, even assuming that Appellants assertions are correct, we do not find, and Appellants fail to demonstrate, that claim 1 precludes the use of an external mail client for sending messages. Therefore, since Appellants have not shown that sending the composite message of claim 1 cannot be accomplished using a mail client, we find that the disclosure of SnagIt and sending the composite message from within the application of claim 1 are equivalent even if “SnagIt requires the use of an external mail client.”

Appellants further argue that hotkeys disclosed by SnagIt are used to “capture an image during execution of an application” but “[have] nothing to do with sending a message” (App. Br. 11). Based on this assertion, Appellants conclude that SnagIt fails to disclose sending a composite message from within the game application to the intended recipient over the network. We are unconvinced by Appellants’ argument because, as set forth above, we find that SnagIt is disclosed as being activated within an application (e.g., MS Word – Fig. 4) and a composite message (including, for example, an image file and an optional short message – Fig. 3) is sent “from within” the application.

It follows that Appellants have failed to demonstrate that the Examiner erred in rejecting claim 1. Therefore, we affirm the rejection of claim 1 and of claims 2-4, 7, 9-13, 19, and 21, which fall therewith.

#### IV. CLAIMS 5, 6, 16, 17, AND 20

As set forth above, we select claim 5 as the sole claim on which to decide the appeal of claims 5, 6, 16, 17, and 20.

Appellants argue that “Snook fails to remedy the deficiencies of SnagIt” (App. Br. 12). However, as set forth above, we do not find, and Appellants have failed to establish, specific deficiencies in the SnagIt reference.

It follows that Appellants have failed to demonstrate that the Examiner erred in rejecting claim 5. Therefore, we affirm the rejection of claim 5 and of claims 6, 16, 17, and 20, which fall therewith.

#### V. CLAIMS 14 AND 15

As set forth above, we select claim 14 as the sole claim on which to decide the appeal of claims 14 and 15.

Appellants argue that Killcommons “fails to remedy the deficiencies of SnagIt” (App. Br. 12). However, as set forth above, we do not find, and Appellants have failed to establish, specific deficiencies in the SnagIt reference.

It follows that Appellants have failed to demonstrate that the Examiner erred in rejecting claim 14. Therefore, we affirm the rejection of claim 14 and of claim 15, which falls therewith.

#### VI. CLAIM 18

Appellants argue that “Toyoda fails to remedy the deficiencies of SnagIt” (App. Br. 13). However, as set forth above, we do not find, and Appellants have failed to establish, specific deficiencies in the SnagIt reference.

It follows that Appellants have failed to demonstrate that the Examiner erred in rejecting claim 18. Therefore, we affirm the rejection of claim 18.

#### VII. ORDER

In summary, the rejections of claims 1-7 and 9-21 under § 103(a) are affirmed.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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